

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	85649865
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 104
<b>MARK SECTION (no change)</b>	
<b>ARGUMENT(S)</b>	
Please see the actual argument text attached within the Evidence section.	
<b>EVIDENCE SECTION</b>	
<b>EVIDENCE FILE NAME(S)</b>	
<b>ORIGINAL PDF FILE</b>	<a href="#">evi_66193100150-164118305_. Response to Final Office Action RASCAL_Design .pdf</a>
<b>CONVERTED PDF FILE(S) (2 pages)</b>	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\856\498\85649865\xml8\RFR0002.JPG</a>
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<b>SIGNATURE SECTION</b>	
<b>RESPONSE SIGNATURE</b>	/Sheila F. Morrison/
<b>SIGNATORY'S NAME</b>	Sheila Fox Morrison
<b>SIGNATORY'S POSITION</b>	Attorney of record, Oregon bar member
<b>SIGNATORY'S PHONE NUMBER</b>	503-241-2300
<b>DATE SIGNED</b>	05/09/2013
<b>AUTHORIZED SIGNATORY</b>	YES
<b>CONCURRENT APPEAL NOTICE FILED</b>	NO
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Thu May 09 16:57:12 EDT 2013

**TEAS STAMP**

USPTO/RFR-66.193.100.150-  
20130509165712708975-8564  
9865-500b9c563dca926b263a  
7bf1e54b319c7eba351ec5796  
a9c633c5ce0b03c3d3e40-N/A  
-N/A-20130509164118305834

PTO Form 1930 (Rev 9/2007)  
OMB No. 0651-0050 (Exp. 05/31/2014)

## **Request for Reconsideration after Final Action To the Commissioner for Trademarks:**

Application serial no. **85649865** has been amended as follows:

**ARGUMENT(S)**

**In response to the substantive refusal(s), please note the following:**

Please see the actual argument text attached within the Evidence section.

**EVIDENCE****Original PDF file:**

[evi\\_66193100150-164118305\\_Response to Final Office Action RASCAL Design .pdf](#)

**Converted PDF file(s)** (2 pages)

[Evidence-1](#)

[Evidence-2](#)

**SIGNATURE(S)****Request for Reconsideration Signature**

Signature: /Sheila F. Morrison/ Date: 05/09/2013

Signatory's Name: Sheila Fox Morrison

Signatory's Position: Attorney of record, Oregon bar member

Signatory's Phone Number: 503-241-2300

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing

him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85649865

Internet Transmission Date: Thu May 09 16:57:12 EDT 2013

TEAS Stamp: USPTO/RFR-66.193.100.150-201305091657127

08975-85649865-500b9c563dca926b263a7bf1e

54b319c7eba351ec5796a9c633c5ce0b03c3d3e4

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This request for reconsideration replies to the Final Office Action issued on November 9, 2012, wherein the Examining Attorney maintained a refusal to register in Class 33 of the Applicant's trademark RASCAL & Design under Serial No. 85/649,865 on the basis that there is a likelihood of confusion between the applied-for mark and the mark represented in Registration No. 3,779,333. For the following reasons the Applicant respectfully requests that the refusal be withdrawn.

The Applicant hereby incorporates by reference its response filed on November 7, 2012.

**Alcoholic beverages are related for the purposes of the likelihood of confusion analysis.** The Trademark Office has consistently regarded different alcoholic beverages as related goods for the purposes of the likelihood of confusion analysis. Accordingly, the Examining Attorney cannot now dismiss the third party marks for related alcoholic beverages and the "crowded field" arguments submitted by the Applicant. As the Examining Attorney states, "[t]he weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks *in use in the marketplace* in connection with *similar* goods and/or services" (emphasis not added). In light of the evidence of dilution of "Rascal" marks provided in the November 7, 2012 response, there appears to be plenty of room for the Applicant's mark to be registered alongside all of the other "Rascal" marks registered or approved for alcoholic beverages.

**The Examiner's reference to consumer experience in the marketplace is made without sufficient evidence and is misplaced.** The Examining Attorney makes references to the consumer experience as a basis for his refusal, including the following (bold emphasis added):

- "... consumers encountering the parties' marks in similar commercial contexts for the identical goods in this case are very likely to confuse the marks based on their shared key term ...";
- "[t]he weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks *in use in the marketplace in connection with similar goods* ..."; and
- "[w]hen a mark consists of word portions and design portions, the literal portions are generally the dominant and most significant features of a mark because consumers will discuss the goods or their source using the wording."

Each of the above Examining Attorney's statements is made without supporting evidence. Further, it is well settled that the Examining Attorney's decisions should be focused primarily on the record in the Register, and not on external information not made of record.

Nevertheless, in light of the Examining Attorney's introduction of this theme, the Applicant herein responds with the following observations.

In the marketplace, in both retail shops and online, wines are often grouped or identified by geographic source. The wines labeled with the cited mark come from Australia, while those labeled by the Applicant are from Oregon. This geographic distinction is commonly recognized by wine consumers and very likely a more significant feature of their discussions and a more important product source distinction than the subject marks. Consumers often look for wine

from a particular country or region before focusing the next step in making their purchasing decisions.

Furthermore, in the case of the registered mark, the THE RASCAL brand appears in context with a significant amount of other content including a house mark “Hugh Hamilton” and the image of a sheep (very emblematic of Australia, I might add).



The point being, if the Examining Attorney is going to rely on the market context to inform his conclusions about whether there is a likelihood of confusion between the applied-for mark and the registered mark, he ought to have all of the relevant information before him.

Further, even if consumers recognize that the bottles of wine with the subject marks share a common term, that does not automatically lead to the conclusion that there is a likelihood of confusion. The overall look and feel of the label, the winemaker, type, style, and geographic source are all the factors relevant in the purchasing decision and each of these are distinctions that are likely to avoid consumer confusion.

In light of the response filed on November 7, 2012 and the foregoing, the Applicant respectfully submits that there is no likelihood of confusion between the cited mark and the Applicant's mark; therefore the 2(d) refusal should be withdrawn and the application be approved for publication.